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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,277	12/28/1999	HIROSHI KOIKE	500-38037XOO	9791

20457 7590 08/26/2003

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EXAMINER	
WORJLOH, JALATEE	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/473,277	KOIKE ET AL.	
	Examiner	Art Unit	
	Jalatee Worjloh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-32* is/are pending in the application.

4a) Of the above claim(s) *23,25,27,28,30 and 31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22,24,26,29 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Prosecution Application

1. The request filed on June 11, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/473277 is acceptable and a CPA has been established. An action on the CPA follows.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 22, 24,26,29,and 32, drawn to distribution scheduling, classified in class 705, subclass 52.

II. Claims 23,28, and 31, drawn to management, classified in class 705, subclass 1.

III. Claims 25, 27 and 30, drawn to licensing, classified in class 705, subclass 59.

The inventions are distinct, each from the other because of the following reasons:
Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as generating a distribution schedule for controlling distribution of said digital contents corresponding to said stores. Also, invention III has separate utility such as calculating a total number said digital content sold for each digital contents holder that licenses digital content to said stores. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Carl Brundidge (Reg. 29,621) on August 6, 2003 a provisional election was made with traverse to prosecute the invention of I, claim22,24,26,29 and 32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23,28,31,25,27 and 30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i). **Note:** this restriction is final.

6. Claims 22, 24, 26, 29 and 32 were examined.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22, 29 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed,

produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2dat 1452. .

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 22, 26, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0002488 to Muyres et al. in view of U.S. Patent No. 5920701 to Miller et al.

Referring to claims 22, 29 and 32, Muyres et al. disclose selecting digital contents corresponding to each of a plurality of stores selling said digital contents, when said selected digital contents is not saved in said stores and selling at each of said stores a particular digital content selected by a customer form said distributed digital contents (see paragraphs [0092] and [0127]). Muyres et al. do not expressly disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. Miller et al. disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule (see col. 1, lines 66-67; col. 2, lines 1-7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art

to modify the method disclose by Muyres et al. to include the step of generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. One of ordinary skill in the art would have been motivated to do this because it accurately coordinates the transfer of data (see Miller et al. col. 1, lines 44-55).

Referring to claim 26, Muyres et al. disclose a distribution control section for selecting digital contents corresponding to each of a plurality of stores selling said digital contents, when said selected digital contents is not saved in said stores and a sales section for selling at each of said stores a particular digital content selected by a customer form said distributed digital contents (see paragraphs [0092] and [0127]). Muyres et al. do not expressly disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. Miller et al. disclose generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule (see col. 1, lines 66-67; col. 2, lines 1-7). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Muyres et al. to include the process of generating a distribution schedule for controlling distribution of said contents corresponding to said stores or instructing distribution of said digital contents to each of said stores according to said distribution schedule. One of ordinary skill in the art would have been motivated to do this because it accurately coordinates the transfer of data (see Miller et al. col. 1, lines 44-55).

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muyres et al. and Miller et al. as applied to claim 22 above, and further in view of U.S. Patent No. 5943422 to Van Wie et al.

Muyres et al. disclose selling at each of said stores, a particular digital content selected by a customer form said distributed digital contents (see claim 22 above). Muyres et al. do not expressly disclose generating a digital content by digitizing an original content and transmitting to a recognition device a request for confirmation of content of said digital content; executing, in response to said request, confirmation of said content of said digital content by determining whether said content of said digital content has been generated without error and transmitting a message indicating whether said content is to be recognized based on said determination and receiving said message and accumulating said content of said digital content if said content of said digital content has been recognized. Van Wie et al. disclose generating a digital content by digit zing an original content and determining whether said content of said digital content has been generated without error (see col. 11, lines 3-5; col. 39, lines 14-22), and receiving a message accumulating said content of said digital content if said content of said digital content has been recognized (see col. 39, lines 31-33). As per the step of transmitting to a recognition device a request for confirmation of content of said digital content and transmitting a message whether said content is to be recognized based on said determination, these are inherent step. Further, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Muyres et al. to include the steps of generating a digital content by digitizing an original content and transmitting to a recognition device a request for confirmation of content of said digital content; executing, in response to said request,

confirmation of said content of said digital content by determining whether said content of said digital content has been generated without error and transmitting a message indicating whether said content is to be recognized based on said determination and receiving said message and accumulating said content of said digital content if said content of said digital content has been recognized. One of ordinary skill in the art would have been motivated to do this because detects and resolves errors during file transfer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306, and 703-746-9443 for Non-Official/Draft .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, V.A., Seventh floor receptionist.

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August 19, 2003

JAMES P. TRAMMELL
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